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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/336,611

Applicant(s)

REAY ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20,22-41 and 45-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20,22-41 and 45-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION***Response to Amendment***

This Office Action is in response to the Applicants' Amendment, paper number 8, filed on December 24, 2002. Claims 21, 42, 43, and 44 have been canceled per the Applicants' request. Claims 1-20, 22-41, and 45-47 are pending and will be considered for examination.

Claim Objections

Claim 46 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 46 is dependent on canceled claim 42. This claim cannot be examined until it is placed in proper dependent form.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 20, and 35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites the limitation "...softgoods that were distributed to the prospective purchasers and then purchased being

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unchanged as result of a purchase transaction.” To support the Examiner’s reasoning for lack of enablement, the Examiner refers to the Applicants’ specification. In particular, the Applicants’ specification states that a user is enabled to preview a softgood that is limited (e.g. lower quality), and that once the user decides to purchase the softgood, the player program registers the softgood on the user’s computer with a registration value to enable full access (see page 4, lines 34 – page 5, lines 8). Furthermore, the specification goes on to state “...the softgood is registered on the user’s computer, e.g., by modifying the softgood to include the registration value...” (page 16, lines 20-28). Clearly, the Applicants’ specification teaches that the softgood that was distributed during preview and the softgood that was purchased are not the same since the purchase transaction requires “modifying the softgood” to enable full access. Likewise, Claim 20 recites the limitation “...registration value identifying a software program used to create the softgood...” This claim also lacks proper support in the specification. Finally, claim 35 recites the limitation “...a purchase of a softgood being initiated when a softgood is being used...” The Examiner is unable to find proper support for this limitation in the Applicants’ specification. For these reasons, these limitations have not been properly enabled under 35 USC 112, first paragraph.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 32, 45, and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation

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"...softgoods that were distributed to the prospective purchasers and then purchased being unchanged as result of a purchase transaction." As analyzed above, this limitation lacks proper support and therefore it is unclear to the Examiner what this limitation means. For examination purposes, the Examiner will assume that this limitation refers to a demo version of a software that can be unlocked to provide a fully functional version as described in the Applicants' specification (page 1, lines 12-27).

Referring to claims 32, 45, and 47, these claims appear to have an internal contradiction in the claim language. These claims recite the limitation of not including any copy protection in the softgood that restricts the user from freely copying and distributing the softgood. However, these claims also require a user to register the softgood in order to obtain a registration value to view the softgood beyond preview. The Examiner would like to point out that a registration value is inherently a form of copy protection since it prevents the user from making a copy of the full version of the softgood. For this reason, these claims will not be examined until the Applicants clarify this issue. Furthermore, claims 32 and 47 are system claims; however, these claims recite process limitations for a method in items c) and d) of both claims. It is unclear to the Examiner how the process limitations of claims 32 and 47 affect the structural elements of the system of these claims. System/apparatus claims should be directed to the structural elements of a system and not to the process of a method. *"Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function."* *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). *"Apparatus claims cover what a device is, not what a device does."* Hewlett-

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Packard Co. v Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528
(Fed. Cir. 1990).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 4, 6, and 7, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Applicants' Admission of Prior Art.

Referring to claims 1, Wiser teaches a method and system for facilitating automated sale of softgoods (column 3, lines 5-10), comprising the steps of:

- providing a program to a creator of the softgoods that automatically includes a unique identifier in each softgood before the softgood is distributed to prospective purchasers, said unique identifier specifically referencing the creator of the softgoods (column 3, line 67; column 4, lines 1-3; column 6, lines 59-67; column 10, lines 49-55; column 11, lines 63-67; column 12, lines 1-11);
- distributing the softgoods to prospective purchasers, such that the distribution is not limited to a distribution over private networks (column 3, lines 5-20; column 6, lines 15-27);
- providing an agency having a server that implements softgood purchase transactions and maintains a database in which data relating to the sale of softgoods are stored (Figure 1B, items 124 and 130; column 5, lines 43-

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65; column 6, lines 4-14; column 9, lines 38-51), such that for softgoods that are purchased, the database maintains data relating to the purchasers of the softgoods.

Wiser does not teach that the softgoods that were distributed to the prospective purchasers and then purchased being unchanged as a result of a purchase transaction (column 3, lines 51-63). However, Wiser teaches that the preview and the complete song are combined into a single media file (column 3, lines 51-63; column 7, lines 4-14, lines 56-62; Figure 2, items "208" and "214"). Wiser relies on streaming technology to deliver the preview portion of the media data file. However, streaming technology does not preclude a user from downloading a file. Indeed, Wiser specifically states "...a consumer should be able to pass on preview music to other potential new customers." (column 2, lines 17-18). How is this possible if the media data file is not made available for download? Furthermore, the Applicants admit that it is well known in the art to download a demo version of a software that can be unlocked to provide full functionality (page 1, lines 12-27). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to download the entire media data file of Wiser onto a potential purchaser's system. The Examiner's notes that this is possible since Wiser uses encryption to secure the complete song from unauthorized access (column 7, lines 27-37). Once a user has registered with Wiser's system and provided payment, the system provides the key to decrypt the song (column 9, lines 25-37). One of ordinary skill in the art would have been motivated to do so in order to avoid requiring

a user to download a second fully functional version as noted in the Applicants' specification (page 1, lines 22-23).

Referring to claims 3, 4, and 7, Wiser teaches all the limitations of claim 1 as noted above. Furthermore, Wiser teaches that the unique identifier of the softgood is assigned to a server (column 4, lines 1-12).

Referring to claim 6, Wiser teaches a program for playing the softgood that also communicates with the server to enable the purchase of the softgood (column 3, lines 33-50; column 4, lines 63-67; column 10, lines 1-16; Figure 1A, item 116; Figure 14).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Applicants' Admission of Prior Art and further in view of Rinearson "Word Processing Power with Microsoft Word".

Wiser and Applicants' Admission of prior art do not teach that the unique identifier for each softgood also references a unique identifier for the program provided to the creator, said program being used to create the softgood. However, Rinearson teaches that a program used by a creator of a softgood automatically adds an extension to the filename (page 54, see underlined portion). Specifically, Rinearson teaches that the program adds a ".DOC" extension to the filename. This extension inherently identifies the program used to create the softgood. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Rinearson into the method of the prior art. One of ordinary skill in the art would have been motivated to do so in order to automate the process of assigning filename extensions as taught by Rinearson. Furthermore, the Examiner

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notes that the limitation of claim 2 is not functionally involved in the steps of the method recited and is therefore considered to be nonfunctional descriptive material. The steps of the method would be performed the same regardless of what the unique identifier referenced. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have the unique identifier reference any data because such data does not functionally relate to the steps of the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Applicants' Admission of Prior Art and further in view of Stefik et al (US Patent 5,629,980). Wiser and Applicants' Admission of prior art teach all the limitations of claim 1 as noted above. Wiser and Applicants' prior art do not teach including a base price within each softgood prior to the step of distributing the softgood. However, Stefik teaches including a fee within each softgood prior to the step of distributing the softgood (column 6, lines 51-56). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the fee of Stefik into the method of the prior art. One of ordinary skill in the art would have been motivated to do so in order to automatically show the purchaser the price of the softgood prior to purchasing.

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Claims 8-12, 14, 17-19, 32, 35-37, 39-41, 45, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Official Notice.

Referring to claims 8, 19, and 32, Wiser teaches a method and computer-executable instructions for facilitating purchase of a softgood that is freely distributed to prospective purchasers for preview with a player program and which includes a unique identifier that is assigned to the softgood before the softgood is distributed, comprising the steps of:

- enabling the prospective purchasers to preview the softgood with the player program to a limited extent, prior to deciding to purchase the softgood, the player program controls access to the softgood and allows the prospective purchaser only limited access to the softgood (column 3, lines 51-63; column 10, lines 1-17);
- enabling purchase of the softgood with the player program by connecting a computer on which the player program is executing with an e-commerce agency to initiate a network transaction, purchase of the softgood causing data related to the purchase to be recorded in the database of the e-commerce agency and causing a registration value that references the unique identifier to be transmitted to the computer on which the player program is executing (column 3, lines 32-50; column 9, lines 26-36; column 10, lines 18-37);

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- using the player program, registering the softgood on the computer employed for the network transaction using the registration value provided by the e-commerce agency, registration of the softgood on the computer enabling the softgood to be played by the player program beyond the limited extent of the preview, the player thereafter allowing a purchaser who has thus purchased the softgood to fully access the softgood (column 3, lines 32-50; column 9, lines 25-36; column 10, lines 1-37).

Wiser does not explicitly teach that the prospective purchaser possesses a complete copy of the softgood. However, Wiser teaches that the preview and the complete song are combined into a single media file (column 3, lines 51-63; column 7, lines 4-14, lines 56-62; Figure 2, items "208" and "214"). Wiser relies on streaming technology to deliver the preview portion of the media data file. However, streaming technology does not preclude a user from downloading a file. Indeed, Wiser specifically states "...a consumer should be able to pass on preview music to other potential new customers." (column 2, lines 17-18). In addition, Wiser uses encryption to secure the complete song from unauthorized access (column 7, lines 27-37). Once a user has registered with Wiser's system and provided payment, the system provides the key to decrypt the song (column 9, lines 25-37). Furthermore, the Applicants admit that it is well known in the art to download a demo version of a software that can be unlocked to provide full functionality (page 1, lines 12-27). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to download the entire media data file of Wiser onto a potential purchaser's system. One of ordinary skill in the

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art would have been motivated to do so in order to avoid requiring a user to download a second fully functional version as noted in the Applicants' specification (page 1, lines 22-23). Wiser also does not explicitly teach that the softgood is previewed and purchased from *within* the player program. However, Official Notice is taken that modular programming is well known in the art. Modular programming reduces a complex program into several smaller programs that are equivalent in function to the original program. However, there is no requirement that a programmer use modular programming. Indeed a programmer may combine several modules into one large program. The choice of using several modules or one large program is one that a programmer makes at the time of design and implementation of the program. Therefore integrating several separate modules into one program would have been obvious since it has been held that making something integral is within the level of ordinary skill in the art, see *In re Larson*, 144 USPQ 347, 349; 339 US 965 (CCPA 1965); *In re Wolfe*, 116 USPQ 443, 444; 251 F2d 854 (CCPA 1958).

Referring to claims 10 and 11, Wiser teaches the steps of using the player program to transmit an identification of a purchaser of the softgood to the e-commerce agency during the network transaction, to enable the e-commerce agency to debit a financial account of the purchaser for a purchase price of the softgood, wherein the financial account numbers of purchasers of softgoods are stored in a database, a financial account number of a purchaser being used to debit an account of said purchaser as a result of the network transaction (column 13, lines 4-58).

Referring to claims 12 and 36, Wiser teaches the step of modifying the softgood to include the registration value and recording the registration value in a file, said registration value referencing the identification of the user (column 4, lines 42-50; column 9, lines 11-18; column 19, lines 61-67; column 20, lines 1-8).

Referring to claim 17, Wiser teaches the step of permitting the softgood to be played with only a substantially reduced quality, unless registered on the computer (column 3, lines 51-63).

Referring to claim 18, Wiser does not explicitly teach the step of sending a message over the network to advise a purchaser of the registration value that was used to register the softgood on the computer of the purchaser. However, Official Notice is taken that it is old and well known in the art to advise a purchaser of the registration value that was used to register a softgood on a computer in order to allow a purchaser to retain the registration value for recording keeping purposes.

Referring to claim 35, Wiser teaches a system for facilitating automated sale of softgoods from which a revenue stream is returned to each creator of the softgoods, each softgood including a unique identifier, comprising:

- creator computers that execute at least one software program used by creators of the softgoods to produce the softgood and to assign the unique identifier to the softgoods produced thereby, said creator computers including network interfaces that couple the creator computers to a publicly accessible network, the creators of the softgoods entering into agreements with an e-commerce agency in which the e-commerce

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agency agrees to facilitate the automated sale of the softgoods and to return a portion of the revenue stream from the automated sale to the creators of the softgoods (column 9, lines 39-51; column 10, lines 49-67; column 11, lines 15-25, lines 49-67; column 12, lines 1-15);

- a server computer operated by the e-commerce agency, said server computer maintaining a database in which data relating to the softgoods are stored, said data including unique identifiers for the softgoods, said server computer also including a network interface coupling the server computer in communication with the publicly accessible network and receiving the unique identifier for each softgood from one of: the creator computers before distribution of the softgood to prospective purchasers; and a user of the softgood at a sale of the softgood, said purchase by a user of the softgood causing the server computer to confirm approval of a credit transaction for the user by an on-line communication with a credit approval agency, and if the credit transaction is approved, to transmit a registration value over the publicly accessible network to a computer of the user to register the softgood on the computer of the user, to enter data related to the purchase within the database, whereas without the registration value, a user is allowed only limited access to the softgood (column 5, lines 43-65; column 8, lines 43-67; column 9, lines 25-37; column 12, lines 1-15; column 13, lines 4-50).

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Wiser does not teach that the purchase of a softgood is initiated when a softgood is being used. However, Official Notice is taken that the use of concurrency is old and well known in the art of programming. Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to use concurrency in the system of Wiser. One of ordinary skill in the art would have been motivated to do so in order to improve performance, responsiveness, and throughput of the system of Wiser.

Referring to claims 39-41, Wiser teaches that media player enables the user to purchase the softgood when executed on the computer of the user and communicates with the server computer over the network to facilitate the purchase of the softgood (Figure 14; column 10, lines 1-17; Figure 1A, item 116; Figure 1B, item 124). Finally, wiser teaches that a preview of the softgood to a limited extent is permitted on the computer of the user before the softgood is purchased, and once the softgood is registered on the computer of the user using the registration value, use of the softgood on the computer of the user is permitted to an extent determined by a license of the softgood (column 3, lines 51-63; column 10, lines 18-48).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Stefik et al (US Patent 5,629,980).

Referring to claim 13, Wiser does not teach the step of including a prohibition of a purchaser modifying the softgood within the softgood. However, Stefik teaches prohibiting the purchaser from modifying the softgood (column 9, line 8; column 11, lines 33-34; column 40, lines 47-67; column 41, lines 1-39). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to

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incorporate the teachings of Stefik into the method and computer program of Wiser. One of ordinary skill in the art would have been motivated to do so in order to protect the authenticity of the softgood.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Official Notice and further in view of Rinearson "Word Processing Power with Microsoft Word".

Wiser and Applicants' Admission of prior art do not teach that the unique identifier for each softgood also references a unique identifier for the program provided to the creator, said program being used to create the softgood. However, Rinearson teaches that a program used by a creator of a softgood automatically adds an extension to the filename (page 54, see underlined portion). Specifically, Rinearson teaches that the program adds a ".DOC" extension to the filename. This extension inherently identifies the program used to create the softgood. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Rinearson into the method of the prior art. One of ordinary skill in the art would have been motivated to do so in order to automate the process of assigning filename extensions as taught by Rinearson. Furthermore, the Examiner notes that the limitation of claim 15 is not functionally involved in the steps of the method recited and is therefore considered to be nonfunctional descriptive material. The steps of the method would be performed the same regardless of what the unique identifier referenced. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d

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1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have the unique identifier reference any data because such data does not functionally relate to the steps of the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Official Notice and further in view of Ronning (US Patent 5,883,955). Wiser teaches the limitations of claim 8 as noted above. Wiser does not teach that the softgood is not usable on the computer for more than a predefined number of times, unless registered on the computer. However, Ronning teaches this limitation (column2, lines 26-29; claim 5). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Ronning into the method of Wiser. One of ordinary skill in the art would have been motivated to do so in order to persuade the user to purchase the softgood.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Official Notice and further in view of Bernard et al (US 5,918,213).

Wiser teaches all the limitations of claim 32 as noted above. Furthermore, Bernard teaches checking the data stored in the database to determine if data for the user purchasing a softgood are already included within the database (column 3, lines

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63-67; column 4, lines 1-20), and if so using a financial account number included in the data for implementing the purchase of the softgood (column 10, lines 39-48). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Bernard into the system of Ronning and Stefik. One of ordinary skill in the art would have been motivated to do so in order to automate the transaction for the purchaser.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Official Notice and further in view of Richardson III (US 5,490,216). Wiser teaches all the limitations of claim 32 as noted above. Wiser does not teach the limitation of claim 34. However, Richardson teaches that the registration value includes at least a name of the purchaser of the softgood (column 8, lines 15-22). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Richardson into the system of Wiser. One of ordinary skill in the art would have been motivated to do so in order to ensure proper licensing procedures of the softgood.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (US Patent 6,385,596 B1) in view of Official Notice and further in view of Stefik et al (US Patent 5,629,980). Wiser does not teach including a base price within each softgood prior to the step of distributing the softgood. However, Stefik teaches including a fee within each softgood prior to the step of distributing the softgood (column 6, lines 51-56). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the fee of Stefik into the

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system of Wiser. One of ordinary skill in the art would have been motivated to do so in order to automatically show the purchaser the price of the softgood prior to purchasing.

Claims 20, 22-24, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronning (US Patent 5,883,955) in view of Official Notice and further in view of Richardson III (US 5,490,216).

Referring to claims 20 and 31, Ronning teaches a method and computer-readable medium having computer-executable instructions for controlling play of a softgood on a computer using a player program, said player program also being employed to purchase the softgood through a network transaction (column 3, lines 50-66; column 4, lines 46-49; Figure 2, items 18, 40, and 42), comprising the steps of:

- enabling a user to preview the softgood on the computer with a player program (column 4, lines 56-67; column 5, lines 1-3; Figure 3, item 46);
- enabling the user to purchase the softgood through a transaction conducted with a player program, such that after the user has purchased the softgood, the softgood is registered on the computer using a registration value provided during the transaction, registration of the softgood on the computer providing access to the softgood in accord with a license to the softgood so that it is thereafter playable on the computer with the player program beyond the preview limit. (column 5, lines 4-15; column 11, lines 1-33; column 12, lines 12-22).

Ronning does not explicitly teach that the registration value identifies a software program used to create the softgood. However, this limitation is not functionally

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involved in the steps of the method recited and is therefore considered to be nonfunctional descriptive material. The steps of the method would be performed the same regardless of what the registration value identified. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have the registration value identify any data because such data does not functionally relate to the steps of the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. Ronning also does not explicitly teach that the softgood is previewed and purchased from *within* the player program. However, Ronning states "Fig.3 is one example of user interfaces for a software or digital information distribution system. Other user interfaces or ways of allowing a user to interact with the system are possible for such a system." (column 5, lines 12-15). Furthermore, Official Notice is taken that modular programming is well known in the art. Modular programming reduces a complex program into several smaller programs that are equivalent in function to the original program. However, there is no requirement that a programmer use modular programming. Indeed a programmer may combine several modules into one large program. The choice of using several modules or one large program is one that a programmer makes at the time of design and implementation of the program. Therefore integrating several separate modules into one program would have been obvious since

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it has been held that making something integral is within the level of ordinary skill in the art, see *In re Larson*, 144 USPQ 347, 349; 339 US 965 (CCPA 1965); *In re Wolfe*, 116 USPQ 443, 444; 251 F2d 854 (CCPA 1958).

Referring to claims 22 and 23, Ronning teaches all the limitations of claim 21 as noted above. Ronning does not teach the limitations of claims 22 and 23. However, Richardson III teaches a method of registering softgoods wherein if the softgood is transferred to a different computer after being purchased, the softgood must again be registered on the different computer to enable the softgood to be played beyond the preview limit on the different computer (column 2, lines 52-55; column 6, lines 34-67, column 7, lines 1-67; column 8, lines 1-38). Furthermore Richardson teaches that the registration value includes at least a name of the purchaser of the softgood (column 8, lines 15-22). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Richardson into the method of Ronning. One of ordinary skill in the art would have been motivated to do so in order to ensure that a purchaser had followed proper licensing procedures of the softgood. The Examiner also notes that the limitations of claim 23 are deemed to be nonfunctional descriptive material since the steps of the method would be performed the same regardless of what information the registration value included, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106.

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Referring to claim 24, Ronning teaches the steps of confirming that a financial account number is valid and transmitting a registration value to the purchaser (column 11, lines 1-28).

Claims 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronning and Bernard et al (US 5,918,213) and further in view of Microsoft Press Computer Dictionary.

Referring to claim 25, Ronning teaches all the limitations of claim 21 as noted above. Furthermore, Ronning teaches storing the registration value so that the purchaser can again reregister the softgood on a computer (column 11, lines 9-13). Ronning does not teach maintaining a database on an e-commerce server in which an identification of each purchaser and a list of each softgood purchased by each purchaser are included, to facilitate distribution of at least a portion of the purchase price of the softgood to a creator of the softgood. However, Bernard teaches the use of a database to facilitate the distribution of at least a portion of the purchase price of the softgood to a creator of the softgood (column 30, lines 42-67). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Bernard into the method Ronning. One of ordinary skill in the art would have been motivated to do so in order to ensure that the creator was paid for his or her work.

Referring to claim 26, Ronning and Bernard teach all the limitations of claim 25 as noted above. Furthermore, Bernard teaches that the data stored in the database also includes a financial account number for each purchaser of softgoods, said financial

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account numbers being provided by the purchasers, further comprising the step of charging the financial account referenced by the financial account number of a purchaser during the transaction (column 3, lines 63-67; column 4, lines 1-20).

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Bernard into the method of Ronning. One of ordinary skill in the art would have been motivated to do so in order to automate the purchase transaction for the purchaser.

Referring to claims 27 and 28, Ronning and Bernard teach all the limitations of claim 26 as noted above. Ronning and Bernard do not teach using the player program to encrypt a financial account number for transmission over a network. However, Microsoft Press teaches a method of Secure Socket Layer (SSL) which is used to encrypt and transmit financial account numbers over a network (page 425-426).

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement the SSL standard as taught by Microsoft in the method of Ronning and Bernard. One of ordinary skill in the art would have been motivated to do so in order to prevent interception of critical information.

Referring to claim 29, Ronning and Bernard teach all the limitations of claim 25 as noted above. Furthermore Bernard teaches that the database includes a current price for each softgood, and the step of advising a purchaser of the current price of the softgood being purchased during the transaction (column 10, lines 24-48). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Bernard into the method of Ronning. One of

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ordinary skill in the art would have been motivated to do so in order to allow the purchaser to decide whether to actually purchase the product.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ronning in view Official Noticew and further in view of Microsoft Press Computer Dictionary. Ronning teaches the limitations of claim 21 as noted above. Ronning does not teach that the player program transmits information over a network using a secure communication protocol. However, Microsoft Press teaches a method of Secure Socket Layer (SSL) which is used to encrypt and transmit financial account numbers over a network (page 425-426). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement the SSL standard as taught by Microsoft in the player program of Ronning. One of ordinary skill in the art would have been motivated to do so in order to prevent interception of critical information.

Response to Arguments

The Applicants' arguments with respect to claims 1, 8, 19, and 35, filed December 24, 2002, have been overcome in-part by a new ground of rejection and in-part by the arguments presented below.

Referring to claim 1 and 35, the Applicants have argued that Wiser does not teach a unique identifier that identifies both a softgood and its creator (see Amendment page 9, lines 13-22). The Examiner respectfully disagrees. Wiser explicitly teaches that the media data file (softgood) (Figure 2, item "200") has media descriptive data (item "204") which contains artist and title information (creator and softgood) (column 6,

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lines 59-67). Furthermore, Wiser teaches that authoring tools (program) are used by an artist to create the data in the media data files (column 10, lines 49-55). The Applicants' specification defines a softgood as a "digital product" (see page 2, lines 6-11; page 7, lines 6-9). Therefore the media data file of Wiser is a softgood since it is a digital product. Finally, the Examiner notes that claim 1 does not explicitly recite that the unique identifier identifies both a softgood and its creator. It states that the softgood "...includes a unique identifier in each softgood..." and "...the unique identifier referencing the creator of the softgoods..." Therefore, claim 1 states that the softgood includes a unique identifier which references the creator only and not the softgood itself.

The Applicants have also argued that Wiser does not teach the limitation "...softgoods that were distributed to the prospective purchasers and then purchased being unchanged as result of a purchase transaction." As noted above under the 112 rejection, this limitation lacks proper support in the Applicants' specification. Assuming arguendo that the Applicants' specification provides support for this limitation, the Applicants have also argued that Wiser requires the media data file to be altered with an encryption key. However, as noted by the Examiner earlier, the Applicants' specification also teaches modifying the softgood.

Referring to claims 8 and 19, the Applicants have argued that Wiser explicitly teaches against free distribution because Wiser displays a purchaser's confidential information in the player. For this reason, the Applicants argue, purchasers are inhibited from distributing full copies of the purchased softgood to third parties. The Examiner disagrees for the following reasons. First, Claim 8 states "...a softgood that is

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freely distributed to prospective purchasers for preview..." This is what Wiser teaches. Wiser explicitly states "...a consumer should be able to pass on preview music to other potential new customers." (column 2, lines 17-18). Second, Wiser teaches that a user's confidential information is displayed only after a transaction is completed (column 4, lines 13-50). Therefore, if a user previews a song but does not purchase it then the player will not display any information and the user is free to distribute the file to other people. The Applicants have also argued that during preview, a user of Wiser's system and method is not in possession of the full softgood. The Examiner disagrees. Wiser explicitly teaches that the preview and full version are combined into a single media file (column 3, lines 51-63; Figure 2). Furthermore, Wiser states that the artist's authoring tool encrypts the data file before it is uploaded to the distribution hub (e-commerce agency) (column 11, lines 63-67; column 12, lines 1-67). Why would Wiser go to great length to encrypt the full song if his intent was solely to store it on the distribution hub until the time of purchase? There would be no need for such encryption since the distribution hub itself would keep the file secure from unauthorized users. Clearly, Wiser's intent for securing the full song on the media data file is to allow for free distribution of the media data file. This way a user can view the free portion of the media file without gaining access to the full song.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Examiner cites the following prior art to support the Official

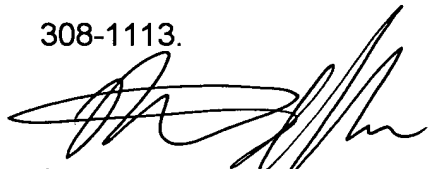
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Notice taken in this Office Action: With respect to claim 20, Carrano et al "Data Abstraction and Problem Solving with C++" teaches that "...one large modular program is not very different from writing many small, independent programs." (page 23); with respect to claim 35, Microsoft Press teaches concurrency (page 91).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

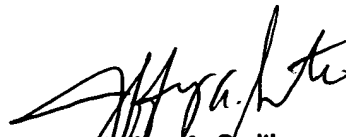
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703)-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-305-7687 for regular communications and (703)-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113.



Naeem Haq, Patent Examiner
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March 10, 2003


Jeffrey A. Smith
Primary Examiner